

REMARKS

This is a response to the final Office Action mailed September 3, 2008. Claims 1-6 are pending.

I. Claim Rejections – 35 U.S.C. § 102

Claims 1-6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miranda (U.S. Patent No. 6,107,575). Applicants respectfully traverse the Examiner's rejection. Reconsideration is requested for at least the following reasons.

To anticipate, a reference must teach each and every claim limitation. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131.

Claim 1 recites, in part, mounting a plurality of side elements to the base element along the linear mating edges by attaching second mounting structures formed on the side elements with the first mounting structure of the respective linear mating edge, the first and second mounting structures being connected to couple the side elements to the base element, a second plurality of the side elements defining side exits extending transversely relative to the linear mating edges, and generally parallel to the planar top surface.

The Action concedes that Miranda fails to disclose the method recited by claim 1. For example, the Action concedes that Miranda fails to disclose or suggest a second plurality of the side elements defining side exits extending transversely relative to the linear mating edges, and generally parallel to the planar top surface.

The Action takes Official Notice that “such cable routing systems typically include side exits extending transversely relative to the linear mating edges...” Action, p. 2. The Action cites Bernard (U.S. Patent No. 6,450,458) in support of this statement. Action, p. 5.

The Examiner’s use of Official Notice is traversed. It is respectfully suggested that including a second plurality of the side elements defining side exits extending transversely relative to the linear mating edges, and generally parallel to the planar top surface within the channel section disclosed by Miranda is not capable of instant and unquestionable demonstration as being well-known. MPEP 2144.03.

For example, as described further below, there is no suggestion as to how one would incorporate the exits shown in the fittings of Figures 10 and 12 of Bernard into the linear channel section disclosed by Miranda.

Miranda fails to disclose all of the limitations of claim 1. As such, Miranda fails to anticipate claim 1. Reconsideration and allowance of independent claim 1 and dependent claim 2 are therefore requested for these reasons.

Claim 3 recites, in part, selecting a plurality of mating elements from a group consisting of side exit elements. Independent claim 3 and dependent claim 4 are therefore patentably distinguished from Miranda. Reconsideration and allowance are respectfully requested.

Claim 5 recites, in part, mounting a plurality of side elements to the base along the opposite sides of the base elements by connecting a first mounting structure defined by the side of the base to a second mounting structure defined by the side elements, wherein the first or second mounting structures fits within the other of the first or second mounting structures to couple the side elements to the base, and wherein a third side element of the plurality of side elements includes a side exit defining portion for exiting parallel to the planar top surface of the base. Independent claim 5 and dependent claim 6 are therefore patentably distinguished from Miranda for at least these reasons. Reconsideration and allowance are respectfully requested.

II. Claim Rejections – 35 U.S.C. § 103

Claims 1-6 are, in the alternative, rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernard in view of Miranda. Applicants respectfully traverse the Examiner's rejection. Reconsideration is requested for at least the following reasons.

The Action concedes that Bernard fails to disclose or suggest a base element and a plurality of side elements mounted thereto. Instead, the Action states that it would have been obvious to form the cable routing system disclosed by Bernard from separate elements as taught by Miranda. This statement is respectfully traversed for at least the following reasons.

A. The References Cannot be Combined as Suggested

Miranda discloses a linear channel section with pivotable wall elements. In contrast, the elements of Figures 10 and 12 of Bernard that are identified in the Action are fittings. Such

fittings are typically attached to the ends of linear sections. See, for example, Fig. 1 of U.S. Patent No. 6,739,795, which shows a linear trough 12 coupled to a fitting 18 by a coupler 14.

There is no suggestion provided as to how one would take the fittings disclosed by Bernard and incorporate the linear sections disclosed by Miranda to arrive at the claimed inventions. Such a combination, as suggested in the Action, could not be made.

B. The References Teach Away from the Purported Combination

References cannot be combined when one reference teaches away from the suggested combination. See KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1740 (citing United States v. Adams, 383 U.S. 39, 50-51, 86 S. Ct. 708 (1966)); MPEP 2143.01 and 2145(X)(D)(2). Bernard teaches away from the purported combination with Miranda because Bernard states the following:

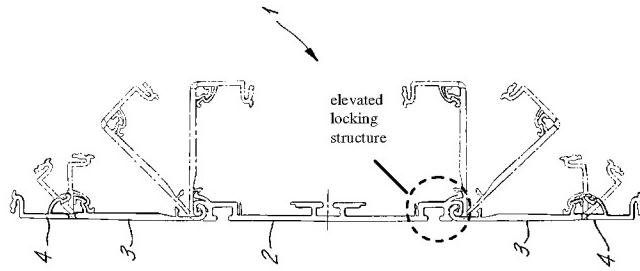
The coupler 100 has an inner wall consisting of two side walls 110 and a bottom wall 120, which are preferably integral and continuous.

Bernard, col. 3, ll. 5-7. Bernard therefore teaches away from forming a base element and a plurality of side elements mounted thereto and cannot be combined with Miranda.

C. The Purported Combination Does Not Arrive at the Claimed Inventions

The Examiner asserts that the combination of the base elements shown in Figures 10 and 12 of Bernard can be combined with the side elements 3 of Miranda to arrive at the claimed inventions. However, if such a combination could be made, the combination does not arrive at the claimed inventions.

If the side elements 3 of Miranda could be coupled to the fittings shown in Figures 10 and 12 of Bernard, the locking structure of the element 2 of Miranda would be required, as shown in Figure 3 of Miranda. This locking structure is elevated with respect to the top surface of the element 2, as shown in Figure 1 of Miranda, reprinted below (annotations added).



This elevation of the locking structure of Miranda would not allow side exits to extend transversely relative to the linear mating edges, and generally parallel to the planar top surface, as required by claim 1.

As such, the purported combination of Miranda with Bernard does not teach all of the limitations of claim 1.

D. There is No Suggestion to Make the Purported Combination

In addition, there is no suggestion as to how or why one skilled in the art would be motivated to modify the fittings disclosed by Bernard based on the channels disclosed by Miranda to arrive at the claimed methods. For example, the Action states that it would have been obvious to form the system of Bernard from separate elements as disclosed by Miranda in order to be able to transport the system in a flat, space-saving condition. The Action further states that such a modification would have been obvious to try because there are only a finite number of predictable solutions.

However, as noted above, claims 1-6 do not simply recite methods that include breaking a cable routing system into various elements, but instead recite specific structures for each of the elements that allow the elements to be assembled according to the steps of the claimed methods. Neither Bernard nor Miranda, alone or in combination, discloses or suggests assembly methods for cable routing systems as recited in claims 1-6.

Further, even if the fittings disclosed by Bernard could be broken into separate elements, there are literally thousands of different ways in which the elements could be formed. For example, the fittings could be divided up in many different ways, and there is no suggestion that a subset of these ways is identified and arrives at predictable solutions. It is therefore respectfully suggested that it would not have been obvious to try because there are not simply a finite number of identified, predictable solutions.

Reconsideration and allowance of claims 1-6 are therefore requested for at least these reasons.

III. Conclusion

Favorable reconsideration in the form of a Notice of Allowance is earnestly solicited. If a telephone conference would be helpful in resolving any issue, the Examiner is urged to contact the undersigned at the telephone number noted.

Respectfully submitted,
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